

diligence from a date of conception prior to 7/20/2000 to the constructive reduction to practice on 8/14/2000.

By a Reply filed on March 14, 2005, Applicant submitted a table that specifically pointed out the sections of previously submitted Exhibit B that show each claimed limitation in independent claim 1, and the corresponding dependent claims. Applicant also submitted a second Declaration of Michael J. Cuttler that presented additional facts establishing diligence from a date of conception prior to July 20, 2000 to the constructive reduction to practice on August 14, 2000. The second Declaration of Mr. Cuttler further established actual reduction to practice of the claimed invention prior to July 20, 2000, which is corroborated by previously submitted Exhibit B. In addition, constructive reduction to practice prior to July 20, 2000 was established by Exhibit B itself, which, according to the Declarations, was created prior to July 20, 2000 and, as previously shown, includes all of the elements of the claimed invention.

In response to the Reply filed on March 14, 2005, the Examiner mailed an Advisory Action on April 12, 2005. In the Advisory Action, the Examiner indicated that "Applicant has failed to provide evidence of diligence in the response filed 14 March 2004 [sic]."

During an interview with the Examiner and the Examiner's supervisor, Joseph Thomas on May 18, 2005, the Examiner indicated that corroborating, documentary evidence is necessary to establish diligence. Such corroborating documentary evidence is submitted herewith in connection with the third Declaration of Michael Cuttler and the Declaration of Jeffrey McFadden, Applicant's attorney.

Remarks

Rule 131 provides that:

- (a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the

rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

Rule 131 further provides that:

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Here, Applicant has demonstrated conception of the invention prior to the effective date of the Williams reference. The effective date of the Williams reference is July 20, 2000. The second Declaration of Michael J. Cuttler, which was submitted with the Reply filed on March 14, 2004 (the "Second Cuttler Declaration"), establishes that the invention was conceived prior to July 20, 2000.

Having established conception prior to the effective date of the Williams reference, in order to overcome the Williams reference, Applicant must show due diligence from prior to the effective date of the Williams reference to the filing date of the application, which is August 14, 2000. More specifically, Applicant must show due diligence from prior to July 20, 2000 to August 14, 2000, a period of time comprising twenty-six (26) days.

Pursuant to the Advisory Action mailed on April 12, 2005, the interview of May 18, 2005 and 37 CFR. 1.131(b), Applicant submits herewith the third Declaration of Michael J. Cuttler (the "Third Cuttler Declaration") and the Declaration of Jeffrey R. McFadden, applicant's attorney. The Third Cuttler Declaration includes corroborating documentary evidence to support that sworn testimony presented in the Second Cuttler Declaration. Specifically, the third Cuttler

Declaration includes Exhibit A, which is a copy of an invoice received from Applicant's attorney. As can be seen from Exhibit A of the Third Cuttler Declaration, Applicant's attorney was preparing the present application from a period of time prior to July 20, 2000 to August 14, 2000, the filing date of the present application. (Certain information printed on the invoice not relevant to the showing of diligence from prior to the effective date of the Williams reference has been redacted.) As can be seen from the invoice, Applicants attorney was working on the application at least as early as of June 28, 2000.

In addition, the Declaration of Jeffrey R. McFadden (the "McFadden Declaration") includes as Exhibit A, a copy of an email dated July 31, 2000, by which Applicant's attorney forwarded to Applicant a draft of the present application. Exhibit A of the McFadden Declaration clearly references the present application by the docket number, i.e., 4590-004. As Applicant's counsel explained during the interview of May 18, 2005, the draft application includes privileged attorney client communications. Thus, Applicant is not submitting the draft of the application itself. Nevertheless, both the Third Cuttler Declaration and the McFadden Declaration include sworn statements that the attachment to Exhibit A of the McFadden Declaration included a draft of the present patent application.

To summarize, the declarations and exhibits submitted by Applicant, including those submitted herewith, establish that the claimed invention was conceived of prior to the effective date of the Williams reference coupled with due diligence from prior to the effective date of the Williams reference to the filing of the application.

In addition, the Second Cuttler Declaration also shows that Applicant reduced the claimed invention to practice prior to the effective date of the Williams reference.

Moreover, the Second and Third Cuttler Declarations show that Applicant conceived the invention prior to the effective date of the Williams reference coupled with due diligence from prior to the effective date of the Williams reference to a subsequent reduction to practice.

Applicant notes that the Advisory Action cites the case of *In re Mulder*, 716 F. 2d 1542, 1545 (Fed. Cir. 1983) to support the assertion that “a 2-day period lacking activity has been held to be fatal.” The rejection of *In re Mulder* was affirmed because the applicant failed to produce any evidence of any activity prior to the effective date. The court stated that Rule 131 “cannot be extended to the point of eliminating all proof of diligence,” and that there was “no evidence whatever of record showing diligence.” Indeed, courts have been liberal in their holdings with respect to the length of time a busy patent attorney may take in the preparation and filing of patent applications. *See, e.g., Farmer et al. v. Schweyer*, 21 C.C.P.A. 865, 68 F.2d 961, 20 U.S.P.Q. 281(1934).

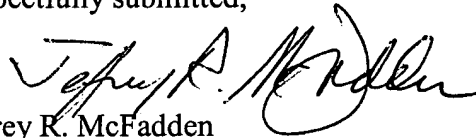
In contrast, in this case, Applicant has provided substantial evidence, including, contemporaneous, corroborating documentary evidence, of due diligence from prior to the effective date of the Williams reference to the filing of the present application. Moreover, any periods of any activity should be excused because they were the result of Applicant’s counsel’s work backlog, which was taken up in chronological order.

It is anticipated that the Examiner will use these Declarations to overcome certain of the prior art references of record, notably the primary reference of Williams et al., U.S. Patent No. 6,618,734. It is thus anticipated that all of the pending claims will be allowed because claims 1-2, 6-15, 17, 25-31, and 47-72 clearly distinguish over all remaining references and combinations thereof. The submission of these Declarations, however, is for expedience, and should not be interpreted as an admission that the Williams reference renders any of the pending claims

unpatentable, or that any combination of Freeman with Peters et al. and/or Sarchione et al., or any combination thereof with other references of record is proper or renders any of claims 1- 2, 6-15, 17, 25-31, and 47-72 unpatentable. Applicant expressly reserves the right to argue and show (in future prosecution, reexaminations, reissues, and litigation) the patentability of claims 1- 2, 6-15, 17, 25-31, and 47-72 over Williams and over all combinations of the references of record, without the benefit of these Declarations.

It is submitted that this Reply, and the previously submitted exhibits and declarations, address all issues and overcome all rejections of the outstanding Office Action, and that the present application has been placed in condition for allowance. Applicant courteously requests early indication of allowance of the present case, including all pending claims 1- 2, 6-15, 17, 25-31, and 47-72. If any issue remains unresolved, Applicant's counsel would appreciate the opportunity for a telephone interview to expedite allowance.

Respectfully submitted,



Jeffrey R. McFadden
Registration No. 46,916
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
One West Fourth Street
Winston-Salem, NC 27101
(336) 721-3730

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